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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/618,129	07/17/2000	Xiao Bing Wang	TRIM1	8510

24504 7590 11/13/2003

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EXAMINER

SPIEGLER, ALEXANDER H

ART UNIT	PAPER NUMBER
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1637

DATE MAILED: 11/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/618,129

Applicant(s)

WANG, XIAO BING

Examiner

Alexander H. Spiegler

Art Unit

1637

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 29 October 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY [check either a) or b)]**

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: 2-9, 11-37 and 39-41.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

8. ☐ The drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☒ Other: See Continuation Sheet

## Continuation of 2. NOTE:

Applicants have proposed amendments to independent claims 37 and 39-41. The claims have been proposed to be amended the following way:

Claim 37 recites methods of detecting or quantifying the presence of a nucleic acid of interest "having a variant of a known nucleotide base in a predetermined position of a known nucleic acid". Previously, the claims were drawn to methods of detecting or quantifying, wherein the target nucleotide base is a mutant nucleotide or a wild type nucleotide base. Thus, Applicants have broadened the scope of the instant claims to include any "known" target nucleotide base.

Claim 39 is drawn to a method detecting the presence of a nucleic acid "having a variant of a known nucleotide base at a predetermined position", wherein during an extension reaction, the non-terminator nucleotides "are not" complementarily matched to the "known nucleotide base at the redetermined position". Previously, the claims were not drawn to a method of detecting the presence of a nucleic acid "having a variant of a known nucleotide base at a predetermined position", and furthermore, the claims did not require that the non-terminator nucleotides "are not" complementarily matched to the "known" nucleotide base.

Claim 40 is drawn to a method for detecting the presence of a nucleic acid "having a known nucleotide at a predetermined position", wherein an extension reaction is carried out and wherein a labeled extension product does not form when the identity of the target nucleotide base "is the same as the known nucleotide base at the predetermined position". Previously, the claims were not drawn to a method of detecting the presence of a nucleic acid "having a known nucleotide at a predetermined position", and furthermore, the claims did not require that the labeled extension product "does not form when the identity of the target nucleotide base is the same as the known nucleotide base at the predetermined position".

Claim 41 recites "one type of terminator nucleotide that is complementarily matched to the known target nucleotide" and that "the absence of a detectable primer extension product indicates the presence of the known target". Previously, the claims distinguished between mutant and wild-type nucleotides, whereas the instant claim corresponds to a "known" nucleotide base, and additionally, in the previous claims, the terminator complementarily matched to a "mutant" nucleotide base, rather than the "known" nucleotide base.

The proposed amendments would require further search, as a further search would be required of a "known" target nucleotide base versus the previously distinguishable detection of either a mutant or wild type nucleotide base. Additionally, further search would be required for methods of detection wherein non-terminator nucleotides are not complementarily matched to the "known" nucleotide base. In addition to further search, further consideration of at least 35 U.S.C. 102 and 103 would be required. Accordingly, because further search and consideration would be required, the proposed amendments will not be entered.

Continuation of 5. does NOT place the application in condition for allowance for the reasons of record, and in view of the non-entry of the amendment filed on October 29, 2003.

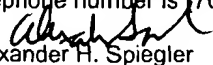
Continuation of 10. Other: The IDS of October 29, 2003 has been considered and the signed PTO-1449 is enclosed.

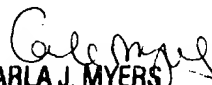
## Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alexander H. Spiegler whose telephone number is (703) 305-0806 or (571) 272-0788 after January 21, 2004. The examiner can normally be reached on Monday through Friday, 7:00 AM to 3:30 PM.

If attempts to reach the examiner are unsuccessful, the primary examiner in charge of the prosecution of this case, Carla Myers, can be reached at (703) 308-2199 or at (571) 272-0747 after January 12, 2004. If attempts to reach Carla Myers are unsuccessful, the examiner's supervisor, Gary Benzion can be reached on (703) 308-1119 or at (571) 272-0782 after January 21, 2004. The fax number for the organization where this application or proceeding is assigned is (703) 872-9306. Applicant is also invited to contact the TC 1600 Customer Service Hotline at (703) 308-0198.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

  
Alexander H. Spiegler  
November 10, 2003

  
CARLA J. MYERS  
PRIMARY EXAMINER